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PTO/SB/21 (08-00)

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E2605  
JUL 8

| TRANSMITTAL FORM   |   | Application Number  | 10/828,594         |
|--|---|---|--------------------|
| (to be used for all correspondence after initial filing)   |   | Filing Date   | April 21, 2004     |
|  |   | First Named Inventor  | Luxem, et al.      |
|  |   | Group Art Unit  | To Be Assigned     |
|  |   | Examiner Name   | To Be Assigned     |
| Total Number of Pages in This Submission   | 9   | Attorney Docket Number  | 1895-14998US02     |
| ENCLOSURES (check all that apply)  |   |   |                    |
| <input checked="" type="checkbox"/> Fee Transmittal Form<br><input checked="" type="checkbox"/> Fee Attached<br><input checked="" type="checkbox"/> Amendment/Reply<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input type="checkbox"/> Information Disclosure Statement<br><input type="checkbox"/> PTO 1449/08A with references<br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Response to Missing Parts/ Incomplete Application<br><input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Assignment Papers (for an Application)<br><input type="checkbox"/> Drawing(s) ( sheets)<br><input type="checkbox"/> Licensing-related Papers<br><input checked="" type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a Provisional Application<br><input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address<br><input type="checkbox"/> Terminal Disclaimer<br><input type="checkbox"/> Request for Refund<br><input type="checkbox"/> CD Number of CD(s) _____ | <input type="checkbox"/> After Allowance Communication to Group<br><input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences<br><input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): |                    |
|  | Remarks   | Enclosed: Petition Under 37 CFR 1.53(e)(2) to be Accorded Filing Date; Preliminary Amendment; Copy of Original Return Receipt Postcard; Return Receipt Postcard for Present Transmittal   |                    |
| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT   |   |   |                    |
| Firm or Individual Name  | McAndrews Held & Malloy, Ltd.   |   |                    |
| Name (Print/type)  | Christopher M. Scharff  | Registration No. (Attorney/Agent)   | 53,556             |
| Signature  |   |   | Date: July 9, 2004 |
| EXPRESS MAIL DEPOSIT   |   |   |                    |
| "Express Mail" mailing label number : EV 435260483 US<br>Date of Deposit July 9, 2004.   |   |   |                    |

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# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

Applicant claims small entity status. See 37 CFR 1.27

**TOTAL AMOUNT OF PAYMENT** (\$ 130.00)

## Complete if Known

|                      |                |
|----------------------|----------------|
| Application Number   | 10/828,594     |
| Filing Date          | April 21, 2004 |
| First Named Inventor | Luxem, et al.  |
| Examiner Name        | To be Assigned |
| Art Unit             | To be Assigned |
| Attorney Docket No.  | 1895-14998US02 |

## METHOD OF PAYMENT (check all that apply)

Check  Credit card  Money  Other  None  
Order

Deposit Account:

Deposit Account Number 13-0017

Deposit Account Name McAndrews, Held & Malloy, Ltd.

The Director is authorized to: (check all that apply)

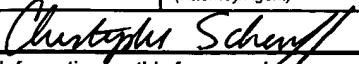
Charge fee(s) indicated below  Credit any overpayments  
 Charge any additional fee(s) during the pendency of this application  
 Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

| Large Entity | Small Entity | Fee Code | Fee (\$) | Fee Code | Fee (\$) | Fee Description  | Fee Paid          |
|--------------|--------------|----------|----------|----------|----------|--|-------------------|
|              |              | 1051     | 130      | 2051     | 65       | Surcharge - late filing fee or oath  |                   |
|              |              | 1052     | 50       | 2052     | 25       | Surcharge - late provisional filing fee or cover sheet.                    |                   |
|              |              | 1053     | 130      | 1053     | 130      | Non-English specification  |                   |
|              |              | 1812     | 2,520    | 1812     | 2,520    | For filing a request for reexamination                                     |                   |
|              |              | 1804     | 920*     | 1804     | 920*     | Requesting publication of SIR prior to Examiner action                     |                   |
|              |              | 1805     | 1,840*   | 1805     | 1,840*   | Requesting publication of SIR after Examiner action                        |                   |
|              |              | 1251     | 110      | 2251     | 55       | Extension for reply within first month                                     |                   |
|              |              | 1252     | 420      | 2252     | 210      | Extension for reply within second month                                    |                   |
|              |              | 1253     | 950      | 2253     | 475      | Extension for reply within third month                                     |                   |
|              |              | 1254     | 1,480    | 2254     | 740      | Extension for reply within fourth month                                    |                   |
|              |              | 1255     | 2,010    | 2255     | 1,005    | Extension for reply within fifth month                                     |                   |
|              |              | 1401     | 330      | 2401     | 165      | Notice of Appeal   |                   |
|              |              | 1402     | 330      | 2402     | 165      | Filing a brief in support of an appeal                                     |                   |
|              |              | 1403     | 290      | 2403     | 145      | Request for oral hearing   |                   |
|              |              | 1451     | 1,510    | 1451     | 1,510    | Petition to institute a public use proceeding                              |                   |
|              |              | 1452     | 110      | 2452     | 55       | Petition to revive – unavoidable   |                   |
|              |              | 1453     | 1,330    | 2453     | 665      | Petition to revive – unintentional   |                   |
|              |              | 1501     | 1,330    | 2501     | 665      | Utility issue fee (or reissue)   |                   |
|              |              | 1502     | 480      | 2502     | 240      | Design issue fee   |                   |
|              |              | 1503     | 640      | 2503     | 320      | Plant issue fee  |                   |
|              |              | 1460     | 130      | 1460     | 130      | Petitions to the Commissioner  |                   |
|              |              | 1807     | 50       | 1807     | 50       | Processing fee under 37 CFR 1.17 (q)                                       |                   |
|              |              | 1806     | 180      | 1806     | 180      | Submission of Information Disclosure Stmt                                  |                   |
|              |              | 8021     | 40       | 8021     | 40       | Recording each patent assignment per property (times number of properties) |                   |
|              |              | 1809     | 770      | 2809     | 385      | Filing a submission after final rejection (37 CFR § 1.129(a))              |                   |
|              |              | 1810     | 770      | 2810     | 385      | For each additional invention to be examined (37 CFR § 1.129(b))           |                   |
|              |              | 1801     | 770      | 2801     | 385      | Request for Continued Examination (RCE)                                    |                   |
|              |              | 1802     | 900      | 1802     | 900      | Request for expedited examination of a design application                  |                   |
|              |              |          |          |          |          | Other fee (specify) Petition Fee under 37 CFR 1.17(h)                      | 130.00            |
|              |              |          |          |          |          |  |                   |
|              |              |          |          |          |          | *Reduced by Basic Filing Fee Paid  |                   |
|              |              |          |          |          |          | <b>SUBTOTAL (3)</b>  | <b>(\$130.00)</b> |

\*or number previously paid, if greater; For Reissues, see above

| SUBMITTED BY      |   |                                      |        |           |                | Complete (if applicable) |
|-------------------|---|--------------------------------------|--------|-----------|----------------|--------------------------|
| Name (Print/Type) | Christopher M. Scharff  | Registration No.<br>(Attorney/Agent) | 53,556 | Telephone | (312) 775-8039 |                          |
| Signature         |  |                                      |        | Date      | July 9, 2004   |                          |

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing this form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.



ATTORNEY DOCKET  
(1895-14998US02)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of: **Franz J. Luxem, ) CERTIFICATE OF MAILING**  
**William M. Troy** )  
Serial No.: **10/828,594** ) I hereby certify that this correspondence is  
Filed: **April 21, 2004** ) being deposited with the United States Postal  
For: **METHOD OF MAKING ALKYL** ) Service as express mail in an envelope  
**ESTERS** ) addressed to: Mail Stop Petitions,  
 ) Commissioner of Patents, P.O. Box 1450,  
 ) Alexandria VA, 22313-1450 on.  
Examiner: **To be Assigned** ) July 9, 2004  
Group Art Unit: **To be Assigned** )  
 ) Express Mail No: EV 435260483 US  
 )  
 ) By: Christopher Scharff  
 ) Christopher M. Scharff  
 )  
 ) Reg. No. 53,556

Mail Stop Petitions  
Commissioner of Patents  
P.O. Box 1450  
Alexandria VA, 22313-1450

**PETITION UNDER 37 C.F.R. §1.53(e)(2) TO BE ACCORDED**  
**FILING DATE AND FILING RECEIPT**

Dear Sir:

Applicants respectfully petition under 37 C.F.R. §1.53(e)(2) that the original filing date of April 21, 2004 be accorded to the above-referenced patent application. A Notice of Incomplete Nonprovisional Application was mailed by the OIPE on July 1, 2004, contending that the application was deficient for not including drawings. However, Applicants respectfully submit that drawings are not necessary for the understanding of the subject matter sought to be patented, under 35 U.S.C. §113 (first sentence).

Specifically, all of the claims of the present application are directed to methods for making alkyl esters or products produced according to those methods. MPEP §608.02 states that:

An OIPE formality examiner should not treat an application without drawings as incomplete if drawings are not required. A drawing is not required for a filing date under 35 U.S.C. 111 and 113 if the application contains:

- (A) at least one process claim including the term "process" or "method" in its introductory phrase;
- (B) at least one composition claim including the term "composition," "compound," "mixture" or "pharmaceutical" in its introductory phrase.

\* \* \* \*

In the present application, every claim is directed to either a method or product made according to a claimed method, and therefore, drawings are not required.

It appears, however, that the Notice of Incomplete Nonprovisional Application was sent by the OIPE because the specification as filed incorrectly made reference to eight missing figures. The references to these eight figures, however, stated that they described testing results and properties only, and therefore were not necessary for the understanding of the invention. Accordingly, Applicants also include with this petition an Amendment to the Specification, to delete the references to the figures in the specification. Applicants believe that this Amendment, in light of the claims as filed (which include at least one process claim), satisfy the OIPE's Notice, and respectfully request that the original filing date of April 21, 2004 be accorded to this application.

In the alternative, the Applicants respectfully submit that the OIPE incorrectly refused to accord this application a filing date, notwithstanding the references in the specification to the missing unnecessary figures. MPEP 606.01(f) states:

"A nonprovisional application having at least one claim, or a provisional

application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP §601.01(g), so long as the application contains something that can be construed as a written description. (emphasis added).

Accordingly, MPEP 601.01(g) states that a Notice of Omitted Items should have been mailed, rather than a Notice of Incomplete Nonprovisional Application, and a filing date should have been accorded to this application. Applicants would have then had the option of accepting the application as deposited in the USPTO, without the referenced drawings, but retaining the original filing date. Applicants could then amend the specification in the same way to delete reference to the missing, unnecessary drawings.

Therefore, under either basis, Applicants respectfully petition the Commissioner to accord the instant application the original filing date of April 21, 2004, and respectfully request a filing receipt which so reflects. Additionally, Applicants enclose the required petition fee of \$130.00 under 37 C.F.R. §1.17(h), and proof of original filing, but request that the fee be refunded and credited to Deposit Account No. 13-0017, in the name of McAndrews, Held & Malloy, Ltd., upon grant of the petition.

Respectfully Submitted,



Christopher M. Scharff  
Attorney for Applicants  
Reg. No. 53,556  
MCANDREWS, HELD & MALLOY, LTD.  
500 West Madison St.  
34<sup>th</sup> Floor / Suite 3400  
Chicago, IL 60661  
(312) 775-8039



ATTORNEY DOCKET  
(1895-14998US02)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of: **Franz J. Luxem, )** CERTIFICATE OF MAILING  
**William M. Troy )**  
Serial No.: **10/828,594 )** I hereby certify that this correspondence is  
Filed: **April 21, 2004 )** being deposited with the United States Postal  
For: **METHOD OF MAKING ALKYL )** Service as express mail in an envelope  
ESTERS ) addressed to: Mail Stop Petitions,  
 ) Commissioner of Patents, P.O. Box 1450,  
 ) Alexandria VA, 22313-1450 on.  
Examiner: **To be Assigned )** July 9, 2004  
Group Art Unit: **To be Assigned )**  
 ) Express Mail No: EV 435260483 US  
 ) By: Christopher Scharff  
 ) Christopher M. Scharff  
 ) Reg. No. 53,556

Mail Stop Petitions  
Commissioner of Patents  
P.O. Box 1450  
Alexandria VA, 22313-1450

PRELIMINARY AMENDMENT

Dear Sir:

In connection with the attached petition under 37 C.F.R. §1.53(e)(2), to be accorded the filing date of April 21, 2004, the Applicants request entry of the following amendment to remove reference to unnecessary Figures 1-8.

**Amendments to the Specification** begin on page 2.

**Amendments to the Specification:**

Please amend the specification as follows:

On page 3, please delete paragraphs 0012-0015;

On page 4, please delete paragraphs 0016-0019;

On page 8, please amend paragraph 0034 as follows:

~~Figures 3 to 6 further demonstrate the transesterification of glycerides in Run 1. Figure 3 shows the results for a  $^1\text{H}$  NMR for acidulated soap stock. Figure 4 shows the results for a  $^1\text{H}$  NMR for a known biodiesel reference. Figure 5 shows the results for a  $^1\text{H}$  NMR for Run 1 at 15 minutes. Figure 6 shows the results for a  $^1\text{H}$  NMR for Run 1 at 120 minutes. Comparison of  $^1\text{H}$ -NMR for acidulated soap stock, known biodiesel reference, and Run 1 at 15 and 120 minutes the graphs of Figure 3 through 6 illustrates the reduction in the presence of glycerides and an increase in the presence of methyl esters showed that glycerides were reduced and methyl esters were increased.~~

On page 17, please amend paragraph 0052 as follows:

~~Figures 7 and 8 show the results for a  $^1\text{H}$  NMR for Runs 6 and 7, respectively. Figures 7 and 8  $^1\text{H}$ -NMR results for Runs 6 and 7 did not reveal any side reactions taking place under the conditions of the reaction scheme, indicating that the reaction scheme of the present invention may be the subject of a continuous process. Additionally,  $^1\text{H}$ -NMR for Run 7 Figure 8 confirmeds that the higher reaction temperature of Run 7 does not have a negative effect as far as decomposition is concerned.~~



**CONCLUSION**

Applicants respectfully request entry of the foregoing preliminary amendment to the specification. Please charge any additional fees or credit any overpayment to Deposit Account No. 13-0017, in the name of McAndrews, Held, & Malloy, Ltd.

Respectfully Submitted,

Christopher M. Scharff  
Attorney for Applicants  
Reg. No. 53,556  
MCANDREWS, HELD & MALLOY, LTD.  
500 West Madison St.  
34<sup>th</sup> Floor / Suite 3400  
Chicago, IL 60661  
(312) 775-8039



ASSISTANT COMMISSIONER FOR PATENTS

Sir: Please place the USPTO receipt stamp hereon and place in outgoing mail to acknowledge receipt of:

Docket No: 1895 - 14998 US02

Applicant: Luxem, et al.

Serial No.: To Be Assigned

Filed: April 21, 2004

Transmittal

Fee \$ 918

Patent Application including:

Page(s) Cover Sheet

12 Page(s) Specification

5 Page(s) Claims # 1-32

1 Page(s) Abstract

0 Page(s) Drawings Formal Informal

Response to Notice of Missing Parts

Declaration & POA Signed Unsigned

Amendment Page(s)

Assignment 4 Page(s) Cover Sheet 1 Page(s)

IDS with PTO-1449 Page(s)

Cited References

Other POA by Assignee & 37 CFR 3.73 Certification

Certificate of Mailing as dated below

Certificate of Express Mailing as dated below

Express Mail Label No. EV 435260695 US

Dated: 4-21-04

Respectfully: **McANDREWS, HELD & MALLOY, LTD.**

Attorneys for Applicant

USPTO  
10/828594  
15439  
04/21/04

